

REMARKS

Status of pending claims

Claims 1-20 are presently pending in the patent application. Without prejudice, Applicant has cancelled claims 12-20, such that just claims 1-11 remain. Because the rejections as to claims 12-20 are now moot, Applicant discusses below the rejections just as they pertain to claims 1-11.

Claim rejections under 35 USC 101

Claims 1-11 have been rejected under 35 USC 101 as being directed to non-statutory subject matter. The Examiner has noted that the entirety of claim 1 in particular recites all software elements, and thus does not recite any statutory patentable subject matter *per se*. In response, Applicant has amended claim 1 to recite hardware which implements the operating system, the application program, and the audio or video program. As such, claim 1 is now directed to statutory subject matter, and Applicant requests that this rejection be withdrawn.

It is noted that the patent application as filed provides support for the amendments that have been made. Paragraph [0019] states that the system 100 includes an operating system 102, an application program 104, and an audio or video program 106. The system 100 is described as being able to be implemented in a desktop or laptop computer, as well as other types of computerized devices. Of course, a desktop or laptop computer, or another type of computerized device necessarily includes or is hardware. As such, the system 100 and its constituent components (i.e., the operating system 102, the application program 104, and the audio or video program 106) are implemented by this hardware.

In this respect Applicant notes that the MPEP states “[t]he subject matter of [a] claim need not be described literally (i.e., using the same terms or in *haec verba*) in order for the disclosure to satisfy the description requirement.” (MPEP sec 2163.02) In this respect, the MPEP states:

By disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing explicit concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter.

(MPEP sec. 2163.07(a))

Claim rejections under 35 USC 102

Claims 1-12 have been rejected under 35 USC 102(e) as being anticipated by Helferich (6,826,407). Applicant submits that these claims are patentable over Helferich. Applicant provides specific reasons as to the patentability of at least some of these claims below. However, Applicant again reiterates as an initial matter that the Examiner has grossly failed to provide a *prima facie* case of anticipation.

The sum total of the explanation of the rejection over Helferich in the Office Action is as follows. The Examiner has recited all the claim limitations of the claims, and then as to claim 1 in particular, quotes column 3, line 19, through column 4, line 6 of Helferich – and also unhelpfully refers Applicant to the “discussion beginning at column 4, line 46.” That is to say, the Examiner has not provided any analysis of Helferich, but merely in effect says that the entirety of Helferich, starting with the summary section, anticipates the claimed invention. Surely the Examiner can recognize that this type of rejection is improper.

Such a rejection very much fails the responsibility of the Examiner to furnish a *prima facie* case of anticipation. The Examiner is aware that “[i]t is by now well settled that the burden of establishing a *prima facie* case of anticipation resides with the Patent and Trademark Office.” In re Skinner, 2 USPQ2d 1788 (BPAI 1986). Under 35 USC 102, every limitation of a claim must identically appear in a single prior art reference for it to anticipate the claim. In re Bond, 15 USPQ2d 1566 (Fed. Cir. 1990). Most significantly, the Federal Circuit expects the Patent and Trademark Office’s “anticipation analysis [to] be conducted on a limitation by limitation basis,

with specific fact findings for each contested limitation and *satisfactory explanations* for such findings.” Gechter v. Davidson, 43 USPQ2d 1030 (Fed. Cir. 1997) (Emphasis added). “Claim construction must also be explicit” *Id.*

Applicant respectfully but strongly asserts that the Examiner has failed to provide a *prima facie* case of anticipation to which Applicant can properly respond. The Examiner in the Office Action has simply delineated the limitations of claim 1 and then summarily without any analysis or explanation concludes that Helferich anticipates these limitations in by quoting from Helferich verbatim, without providing any explanation as to which elements in Helferich correspond to which elements or limitations of the invention. Helferich is a complex reference, and Applicant can only guess which elements the Examiner intends to correspond with which limitations of claim 1.

However, determining which elements of Helferich correspond to which limitations of the claims is not Applicant’s obligation – it is the Examiner’s obligation to provide an anticipation analysis on a limitation by limitation basis, as indicated in the Gechter decision, to warrant a *prima facie* case of anticipation. Indeed, 37 CFR 1.106(b) notes that “[w]hen a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated *as nearly as practicable.*” (Emphasis added) However, the Examiner has not designated which parts of Helferich correspond to the various limitations and elements of the claims. The Examiner has just stated that a large excerpt of Helferich (in fact, nearly the entirety of Helferich!) disclose every limitation of claim 1. The Examiner has made no attempt at claim construction either.

Therefore, Applicant strongly submits that the Examiner has failed to provide a *prima facie* case of anticipation of the claims in question as to Helferich. The completely conclusory nature of the Examiner’s rejection contains no analysis, and no indication where in Helferich the Examiner finds the limitations and elements of the claimed invention (indeed, as to the “discussion beginning at column 4, line 46,” the Examiner simply refers to the detailed description of

Helperich in its entirety!). The Examiner should surely recognize that this rejection would easily not be upheld on appeal.

Now, the Examiner has stated that under 37 CFR 1.111 Applicant must distinctly and specifically point out how the language of the claims patentably distinguishes them from the references. However, what the Examiner fails to recognize is that such a response by Applicant is to be made in relation to a *proper prima facie* case of anticipation first having been made by the Examiner. The Examiner cannot simply in effect say “this reference anticipates the claimed invention,” without any analysis, and then expect Applicant to do the Examiner’s job for him by pointing to 37 CFR 1.111; 37 CFR 1.111 presumes that the Examiner has made a proper *prima facie* case of anticipation in the first. Again, it is the Examiner, not Applicant, who has the initial burden during the examination process. The Examiner’s attempt to short-circuit his initial burden by stating that it is now Applicant’s duty to distinctly and specifically point out how the claims are patentably over the cited reference – after the Examiner has grossly failed to satisfy his burden – is simply improper.

Claim 1

With respect to claim 1, as best as Applicant can tell, the system of this claim corresponds to the communication system of Helperich, the application program corresponds to the integrated mail gateway, and the audio or video program corresponds to a communication device. Again, it is the Examiner’s job to map the components of Helperich to the elements of claim 1, but he has failed to do this. Applicant will therefore proceed on the basis that Applicant’s proffered interpretation is correctly, in light of no competing interpretation from the Examiner.

First, the communications system of Helperich does not include an operating system on which both the application program and the audio or video program run, in contradistinction to the claimed invention. For example, consider the communications system of FIG. 1 in Helperich. There is an integrated mail gateway 150 and multiple communication devices, such as the mobile

devices 105. The gateway 150 is thus a separate device or component from the mobile devices 105. Presumably, the integrated mail gateway 150 has its own operating system, and each of the mobile devices 105 has its own operating system. That is to say, the communications system of FIG. 1 itself does not have an operating system on which *both* the integrated mail gateway 150 and each of the mobile devices 105 run. For just this reason, the claimed invention is patentable over Helperich.

Stated another way, consider a typical mobile device 105, such as the mobile telephone 145 as depicted in FIG. 1 of Helperich. The mobile telephone 145 has its own operating system of course, to run the programs that provide the functionality of the telephone 145. It belies common sense that a totally separate device – the integrated mail gateway 150 – shares this operating system with the mobile telephone 145 such that there is an operating system on which both the telephone 145 and the gateway 150 can be considered as running, in contradistinction to the claimed invention. This is antithetical to all modern understanding of how operating systems work, and unless Helperich says something to the contrary, it is not inherent that Helperich discloses this aspect of the invention. Indeed, Helperich does not even use the phrase “operating system” anywhere!

Second, Helperich does not disclose an audio video program that is separate from but integrated with the application program *such that the application program is unaware that the audio or video program has been integrated therewith*, in contradistinction to the claimed invention. In Helperich, the audio or video program (i.e., the mobile device 105) may be integrated with the application program (i.e., the integrated mail gateway 150) insofar as the former can retrieve messages from and send messages to the latter (see, e.g., col. 3, ll. 43-60). However, it is not true in Helperich that *the integrated mail gateway 150 is unaware that that the mobile device 105 has been integrated therewith*, in contradistinction to the claimed invention. Indeed, insofar as a mobile communications device “establish[es] a telephone call with [the] integrated mail gateway” (col. 3, ll. 43-47), the reverse is actually true – the integrated mail

gateway 150 is *aware* that the mobile device 105 has been integrated therewith. That is to say, without any explicit indication in Helperich to the contrary, inherently if one device *calls* another device, then it can be concluded that the latter device is *aware* of the former device, and not *unaware* as in the invention. For just this reason as well, the claimed invention is patentable over Helperich.

Third, Applicant notes that the claimed invention has been amended so that the user of the application program “directly interact[s] with the application program.” Support for this amendment is found in the patent application as filed at least in paragraph [0020], in which it is noted that the application program 104 can include email programs and word processing programs, among other types of programs. As is inherent in such email programs and word processing programs, a user *directly* interacts with these programs. That is, I can directly use an email program to enter and send an email message, and I can directly use a word processing program to create and edit a document. As noted above, the MPEP states “[t]he subject matter of [a] claim need not be described literally (i.e., using the same terms or in *haec verba*) in order for the disclosure to satisfy the description requirement.” (MPEP sec 2163.02)

However, Helperich does not disclose an application program such that a user thereof *is to directly interact with the application program*, in contradistinction to the claimed invention. As discussed in column 3, lines 35-60, the user (i.e., the person) only *directly* interacts with the communication device (i.e., the audio or video program) in Helperich. The user does *not directly* interact with the integrated mail gateway (i.e., the application program) in Helperich, in contradistinction to the claimed invention. Rather, the user *indirectly* interacts with the integrated mail gateway/application program in Helperich, by using the communication device/audio or video program. For instance, “the second person *uses the communication/mobile] device to transmit . . . to the IMG [integrated mail gateway] addressing information . . .*” (col. 3, ll. 49-52). For just this reason, too, the claimed invention is patentable over Helperich.

Claims 2 and 5-11

Claims 2 and 5-11 are dependent claims, depending from claim 1, and therefore are patentable at least because they depend from a patentable base independent claim, claim 1.

Claim 3

Claim 3 is a dependent claim, ultimately depending from claim 1, and therefore is patentable at least because it depends from a patentable base independent claim, claim 1.

Applicant submits, however, that claim 3 is independently patentable over Helferich, irrespective of the patentability of claim 1. Claim 3 is limited to the audio or video program being integrated with the application program “by subclassing into a window of the application program.” The Examiner has unhelpfully referred Applicant to FIGs. 7-8 of Helferich and their associated text, without any explanation as to how these figures and text describe an audio or video program being integrated with the application program specifically by the audio or video program “subclassing into a window of the application program.” Indeed, Applicant has reviewed Helferich in detail, and can find no disclosure of the terminology “subclassing,” let alone any discussion that corresponds to what subclassing means to those of ordinary skill within the art.

More specifically, Applicant notes that subclassing is a technique used in graphical user interface (GUI)-oriented operating systems, such as the Microsoft Windows operating system. More information regarding subclassing can be located at the Internet web site <http://www.aaronballman.com/programming/REALbasic/WindowSubclassingArticle.php>. Now, FIGs. 7 and 8 of Helferich simply show display screens displayed on the communication/mobile device, which correspond to the audio or video program of the invention. Indeed, in Helferich, *the application program – i.e., the integrated mail gateway – does not actually have any windows*, since no user directly communicates with the integrated mail gateway. Therefore, it cannot be said that the audio or video program subclasses into a window of the application program in Helferich, *at least because* the application program in Helferich *does not have a*

window. The windows depicted in FIGs. 7 and 8 are windows of *the audio or video program*, in other words, and not of the application program.

Moreover, even if the application program in Helferich has a window, the only integration between the application program/integrated mail gateway and the audio or video program/communication or mobile device described in Helferich is that the latter *communicates* with the former. As noted above in relation to claim 1, the mobile device in Helferich can retrieve messages from and send messages to the integrated mail gateway in Helferich (see, e.g., col. 3, ll. 43-60). This type of integration is *not* window subclassing as understood by those of ordinary skill within the art (again, see the referenced web site to understand what window subclassing is). Therefore, for at least these reasons, the Examiner has not provided a *prima facie* case of anticipation of claim 3, such that claim 3 is patentable over Helferich.

Claim 4

Claim 4 is a dependent claim, ultimately depending from claim 1, and therefore is patentable at least because it depends from a patentable base independent claim, claim 1.

Applicant submits, however, that claim 4 is independently patentable over Helferich, irrespective of the patentability of claim 1. Claim 4 is limited to the audio or video program being integrated with the application program “by hooking into a window of the application program.” The Examiner has unhelpfully referred Applicant to FIGs. 7-8 of Helferich and their associated text, without any explanation as to how these figures and text describe an audio or video program being integrated with the application program specifically by the audio or video program “hooking into a window of the application program.” Indeed, Applicant has reviewed Helferich in detail, and can find no disclosure of the terminology “hooking,” let alone any discussion that corresponds to what hooking means to those of ordinary skill within the art.

More specifically, Applicant notes that hooking is also a technique used in graphical user interface (GUI)-oriented operating systems, such as the Microsoft Windows operating system.

More information regarding subclassing can be located at the Internet web site <http://msdn.microsoft.com/en-us/library/ms997537.aspx>. Now, as explained above, FIGs. 7 and 8 of Helperich simply show display screens displayed on the communication/mobile device, which correspond to the audio or video program of the invention. Indeed, in Helperich, *the application program – i.e., the integrated mail gateway – does not actually have any windows*, since no user directly communicates with the integrated mail gateway. Therefore, it cannot be said that the audio or video program subclasses into a window of the application program in Helperich, *at least because the application program in Helperich does not have a window*. The windows depicted in FIGs. 7 and 8 are windows of *the audio or video program*, in other words, and not of the application program.

Moreover, even if the application program in Helperich has a window, the only integration between the application program/integrated mail gateway and the audio or video program/communication or mobile device described in Helperich is that the latter *communicates* with the former. As noted above in relation to claim 1, the mobile device in Helperich can retrieve messages from and send messages to the integrated mail gateway in Helperich (see, e.g., col. 3, ll. 43-60). This type of integration is *not* window subclassing as understood by those of ordinary skill within the art (again, see the referenced web site to understand what window hooking is). Therefore, for at least these reasons, the Examiner has not provided a *prima facie* case of anticipation of claim 4, such that claim 4 is patentable over Helperich.

Conclusion

Applicant has made a diligent effort to place the pending claims in condition for allowance, and request that they so be allowed. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Michael Dryja, Applicant's Attorney, at 425-427-5094, so that such issues may be resolved as expeditiously as possible. For these reasons, this application is now considered to be in condition for allowance and such action is earnestly solicited. Applicant strongly contends that the Examiner's prior art rejection of the claimed invention would not be sustained on appeal.

Respectfully Submitted,



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